

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROYUKI MASUDA, KINYA IRI, KENICHIRO NOGI,
and NOBUO MAMADA

Appeal No. 2004-0642
Application No. 09/635,098

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's rejection of claims 16 and 19, the only claims pending in this application. Although the rejection dated Sep. 12, 2002, Paper No. 14, was not a final rejection, we have jurisdiction of this appeal under 35 U.S.C. § 134 because these claims have been "twice rejected." See 35 U.S.C. § 134(a) (2002).

According to appellants, the invention is directed to a chip inductor and a chip inductor array, which include a plurality of

coiled conducting wires, a magnetic member, connecting electrodes and external electrodes (Brief, page 3).¹ Representative independent claim 16 is reproduced below:

16. A chip inductor comprising:

a plurality of conducting wires closely wound in a coiled manner, each having exposed ends;

a magnetic member in which said plurality of conducting wires are embedded along a direction in which said magnetic member extends;

connecting electrodes to connect, in series, said exposed ends of each of said conducting wires; and

external electrodes which are connected to respective end portions of said conducting wires.

The examiner relies on the following references as evidence of obviousness:

Kato et al. (Kato)	5,544,410	Aug. 13, 1996
Sasaki et al. (Sasaki) (published Japanese Patent Application) ²	06-163272	June 10, 1994

Claims 16 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sasaki in view of Kato (Answer, page 3, referring

¹We refer to and cite from the "Supplemental Appeal Brief" dated Mar. 12, 2003, Paper No. 16, which incorporates by reference the Appeal Brief dated June 24, 2002, Paper No. 13.

²In addition to the English abstract of this document previously made of record, we rely upon and cite from a "machine translation" of this document made of record on May 30, 2003.

to Paper No. 14). We reverse this rejection essentially for the reasons stated in the Brief, Reply Brief, and for those reasons set forth below.

OPINION

The examiner finds that Sasaki discloses all of the limitations of claim 16 on appeal except that the conductors are not "wound in a coil [sic, coiled] manner." Paper No. 14, page 3. Therefore, the examiner applies Kato for the teaching of embedding a closely wound coil in the magnetic body of a chip inductor (*id.*).³ From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art to use the coil design of Kato for the conductors of Sasaki "for the purpose of enhancing the inductance of the inductor." *Id.* We disagree.

As correctly argued by appellants (Brief, pages 6-7), Sasaki teaches the desire to produce a conductor with a small inductance component by using a linear conductor instead of a coil-formed conductor, thus yielding a noise filter with improved properties.⁴

³We also note that appellants disclose that it was conventional to wind a conducting wire around a bar of magnetic material "in a coiled manner." Specification, page 1, ll. 10-20.

⁴See Paragraph [0034] of the machine translation, which is similar to appellants' translation submitted at page 6 of the Brief.

Accordingly, the examiner's statement that it would have been obvious to combine the references "for the purpose of enhancing the inductance of the inductor" (Paper No. 14, page 3) has been refuted by this disclosure of Sasaki (see the Brief, pages 6-7). A reference which "teaches away" from the claimed subject matter is strong evidence of non-obviousness. See *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994); and *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). As correctly pointed out by appellants (Reply Brief, unnumbered page 2), the examiner does not specifically address this argument (see the Answer, argument [2] on page 3, with the response on page 4). Additionally, the examiner fails to identify any other reason or suggestion for the proposed combination of references, only stating that both references are directed to penetrating conductors used in chip type inductors (Answer, page 4). It is incumbent upon the examiner to identify a *clear and particular* reason or suggestion to combine the references as proposed in the rejection, and not to rely on general statements. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the examiner has failed to establish

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a *prima facie* case of obviousness in view of the reference
evidence. Therefore we cannot sustain the examiner's rejection
on appeal.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

TAW/jrg

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